

THIS DISPOSITION IS
NOT CITABLE AS PRECEDENT
OF THE TTAB

Mailed: August 10,
2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Canter & Associates, Inc.

Serial No. 76396925

Mark B. Harrison of Venable LLP for Canter & Associates,
Inc.

Linda A. Powell, Trademark Examining Attorney, Law Office
106 (Mary Sparrow, Managing Attorney).

Before Walters, Chapman and Holtzman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Canter & Associates, Inc. (a California corporation)
has applied to register LEE CANTER'S RESPONSIBLE BEHAVIOR
CURRICULUM GUIDE on the Principal Register as a trademark
for goods ultimately amended to read "educational
publications, namely, printed guides in the field of
classroom management" in International Class 16.¹ Applicant

¹ The application was filed on April 16, 2002, listing no basis therefor as is allowed pursuant to Trademark Rule 2.21. Thereafter, on March 24, 2003, applicant filed a declaration that it has and has had since the filing date of the application a

disclaimed the words "curriculum guide"; and applicant included the following statement: "The name 'Lee Canter' in the mark identifies a living individual whose consent is of record."

The examining attorney has refused registration of the proposed mark under Sections 1, 2 and 45 of the Lanham Act, 15 U.S.C. §§1051, 1052 and 1127, on the ground that LEE CANTER'S RESPONSIBLE BEHAVIOR CURRICULUM GUIDE, as used on the specimen of record, is the title of a single creative work and as such does not function as a mark to identify the source of the goods.

When the refusal of registration was made final, applicant filed an appeal. Applicant and the examining attorney have filed briefs, but applicant did not request an oral hearing.

The question presented by this appeal is whether the title of a single work may be registered as a trademark. Applicant does not contend that LEE CANTER'S RESPONSIBLE BEHAVIOR CURRICULUM GUIDE is anything other than the title of the single work, as depicted in the specimen of record. Rather, applicant argues that "there is no per se

bona fide intention to use the mark in commerce. Applicant also filed on March 23, 2003 an Amendment to Allege Use, with a specimen and claiming May 2002 as applicant's date of first use and first use in commerce, which was accepted by the USPTO.

prohibition against trademarks for books" citing *In re Cooper*, 254 F.2d 611, 117 USPQ 396 (CCPA 1958); that "the 'title' of a creative work should be registrable if it serves to identify and distinguish the source of the goods" citing *In re Scholastic Inc.*, 23 USPQ2d 1774 (TTAB 1992), and "there is no reason why this should not be applied to a single book"; that if applicant's mark were used as the title of a single board game or a single computer program, registration would be allowed; and that because applicant uses the mark in a trademark manner and it identifies the source of applicant's goods, registration "should not be denied solely on the basis that the mark is used as a book title." (Applicant's brief, pp. 2-3.)

The Examining Attorney contends that the proposed mark LEE CANTER'S RESPONSIBLE BEHAVIOR CURRICULUM GUIDE is used by applicant not as a trademark, but as the title of one book (or educational guide), appearing in large lettering covering the major portion of the cover, and with other references on the specimen referring to the title of the educational guide book; that applicant has made no showing of any other book bearing this mark; that the proposed mark is not used as a trademark for a series of books but rather as the title of a single work; that consumers will perceive the proposed mark as the title of the book; and that

applicant's argument about the registrability of marks for different goods (i.e., computer programs and games) is not relevant in view of the law on the titles of books.

Our primary reviewing Court, the Court of Appeals for the Federal Circuit, stated in the case of *Herbko International, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002) that its own precedent "clearly holds that the title of a single book cannot serve as a source identifier. (Footnote omitted) *In re Cooper*, 45 C.C.P.A. 923, 254 F.2d 611, 614-615, 117 USPQ 396, 399-400 (CCPA 1958)(titles of single books cannot be registered as a trademark); ... Thus, the publication of a single book cannot create, as a matter of law, an association between the book's title (the alleged mark) and the source of the book (the publisher)."

The Court explained that book titles are often descriptive of book contents, and that "Regardless of the actual relation of the title to the book, this court's precedent has treated all single works, such as single book titles, as 'inherently descriptive' at best and 'inherently generic' at worst." *Herbko v. Kappa*, 64 USPQ2d at 1379. Another reason for foreclosing trademark rights to the title of a single work results from the interplay between copyright law and trademark law. The Court concluded, "In

sum, this court's case law prohibits proprietary rights for single book titles." *Herbko v. Kappa*, 64 USPQ2d at 1380.

Applicant here acknowledges that its proposed mark is the title of a single book (or educational guide). Further, we agree with the Examining Attorney that applicant's use of the words LEE CANTER'S RESPONSIBLE BEHAVIOR CURRICULUM GUIDE is clearly as the title of the book and would be perceived by consumers as the title, not as trademark use.

Applicant's citation to *In re Scholastic Inc.*, 23 USPQ2d 1774 (TTAB 1992) is inapposite as there the mark was not the title of a single work, but rather was for "a series of non-fiction picture books for children."

Decision: The refusal of registration under Sections 1, 2 and 45 of the Trademark Act is affirmed.